

REMARKS/ARGUMENTS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments and the following remarks.

Claim 14 has been amended to change the term "lid element" to now claim "casing element"

The Examiner has rejected claims 14-17, 20, and 21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,859,979 to *Egger*.

This rejection is respectfully traversed.

First, with the *Egger* disclosure, it is evident that the hinge cup constitutes one single piece. For example, the body of the hinge cup 5 is completely cylindrical

It is respectfully submitted that it is not obvious to a person skilled in the art to transform the hinge cup 5 into a multi-part container, in order to separately house and render the decelerating device autonomous and functional even when separate from the cup. The hinge is, complete and fully functional even

without the decelerator and there is no motivation from Eggar whatsoever to manufacture the hinge cup in two or more distinct pieces.

Thus, with a separate hinge as claimed in claims 14 and 28, it is possible to apply the deceleration device comprising decelerating elements contained in a container separate from the cup 6 and comprising of elements 14, 14', 14'' and 22, 26, 26'. Naturally, this container is devised in such a manner so as to be housed in the space between the cup and the lateral surface of the hole in the furniture door into which it is inserted. This device can be assembled and can function autonomously from the hinge cup, a feature not presented by *Eggar*.

Thus, it is respectfully submitted that it would not be obvious to a person skilled in the art to transform the base 6 of the cup into a hollow container to house the plates of the decelerating device, or vice versa modify the device of *Egger* to add an additional housing. For example, *Eggar* teaches away from including any extraneous damping elements. In column 3, lines 10-21:

Compared with known braking and damping devices of cabinet fittings, the invention offers substantial

advantages... Furthermore, the design of the cabinet fitting is very compact because no external damping elements are needed. The braking and damping device is integrated in the hinge and is not visible externally. Altogether the cabinet hinge remains unchanged externally, that is, no change is necessary in design. The size likewise remains the same.

It is respectfully submitted that the Federal Circuit has held that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) See also MPEP 2143.01

It is submitted that to alter the design of *Egger* as the Examiner proposes would go against both the intention of *Egger* as indicated above, and also against the holding of the Federal Circuit in *In re Gordon*.

It is respectfully submitted that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

Therefore, it is respectfully submitted that it would not be

obvious to modify the design of *Egger* into a new previously unknown design. The Examiner essentially proposes that it would be obvious to modify the design of *Egger*, against the stated goals of *Egger* to a new design not disclosed in *Egger* or in any other piece of prior art. It is respectfully submitted that this type of modification, even if possible, would only be possible through impermissible hindsight after reviewing the present invention as claimed in claims 14 and 28. Therefore, it is respectfully submitted that the invention as claimed in claims 14 and 28 is not obvious in view of *Egger* and is therefore patentable over the above cited reference.

In addition, it is respectfully submitted that it would also not be obvious to also:

- 1) substitute the fixed nature of the decelerating device by holes for assembling it with the cup using pins;

- 2) provide an additional element adapted to guide the driver plate and close the device so as to render the device functional separate from the cup;

- 3) modify the cylindrical form of the cup such that the aforementioned elements have space in the hole milled in the

furniture door when the hinge is mounted.

It is respectfully submitted that the aperture in the hinge cup 5 of *Egger* is of a specific profile in order to guide the sliding element. Starting from *Egger*, it would therefore not be possible to conceive a dampening device attached to a separate casing element to be mounted on a conventional hinge cup, which would not have this stepped profile.

Furthermore, even if the if the dampening device were somehow to be mounted onto the hinge cup of *Egger* as a separate unit, the stepped profile of the hinge cup opening would require a very specific alignment with the sliding element in order to be operationally functional.

Unlike with the present invention as claimed in claim 14, this fixing step would therefore not be a fast operation.

It is respectfully submitted that one of the advantages of a separate dampening device that is self-contained as one unit and is ready to be stored, transported and handled without problems during mounting onto the hinge cup. The separate housing forms a container for the viscous medium in which the slider is immersed. If the slider of *Egger* were to be mounted onto the hinge cup in a

separate step, it is unclear how this viscous medium would be maintained on the dampening device during storage, transportation and handling.

With respect to claim 29, with the present invention as claimed in claims 14 and 28 and as shown by way of example in FIG. 2, the first housing or cup has an aperture 60 of the first housing or cup that is much more narrow than aperture 15, 15', 15'' of the second housing or cup.

This second aperture 15, 15', and 15'' allows a connection element 16, 16', 16'' to be guided therein in casing 14, 14', 14''. In fact, aperture 60 simply constitutes an aperture in order to be able to access the deceleration device, which can be applied underneath the cup.

With respect to the fast connection means of claim 14 and the pins of claim 15, holes are provided to permit it to be rapidly mounted on the cup using the same pins 7,8 that link the cup to the 6 to the rockers 2,3.

In the *Egger* device, the pins 19 link only the cup 5 to the levers 3,4. The remainder is considered part of the same cup. Thus, it is respectfully submitted that because *Egger* is a single

housing type device, it would not be obvious to include a fast connection means for connecting a separate housing to a cup.

Based upon the above aforementioned arguments, it is respectfully submitted that claims 14-17, 20-22, 24, and 28-30 are patentable.

The Examiner has also rejected claims 22 and 24 under 35 U.S.C. 103(a) as being unpatentable over *Egger* in view of *Martin*.

It is respectfully submitted that because claim 14 is patentable, claims 22 and 24 which depend from claim 14 are also patentable.

Claims 28-30 have been added. Support for claims 28-30 is found in the drawings, particularly FIG. 5, and also in the specification on page 5 last paragraph and page 6 and also in FIGS. 13 and 21.

It is believed that no fee is due, however if a fee is due the Commissioner is hereby authorised to charge Collard & Roe, P.C.'s deposit account 03-2468 in the amount necessary for any fee or to credit this account for any overpayment.

In view of the foregoing, it is respectfully requested that

the remaining claims be passed to issue.

Respectfully submitted,
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